

Notice of Allowability

Application No.

10/659,160

Examiner

Celia Chang

Applicant(s)

WEBB ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to 1'2/22/04 election and examiner's amendment attached.
2. ☐ The allowed claim(s) is/are 1,2,4,5,7-13,16-22 and 26-35.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date attached.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.


Celia Chang
Primary Examiner
Art Unit 1625

DETAILED ACTION

1. Applicant's election with traverse of group I in the reply filed on Dec. 22, 2004 is acknowledged. The traversal is on the ground that the method claims should be rejoined. This is not found persuasive because a rejoinder can only be limited to when the method claims are amended to the same scope of the elected compounds.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-5, 7-13, 16-22, 26-31, 35 reading on the elected compounds are prosecuted. Claims 32-34 limited to the elected compounds can be rejoined with the elected compounds. Please note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner i.e. rejoined, before the patent issues. See MPEP § 804.01.

2. *Examiner's Amendment*

Authorization for this examiner's amendment was given in a telephone interview with Ms. Choi on Mar. 12, 2005.

Claim 1. 8th line after the formula, after "X and Y are", *delete lines 8-13*:

“,independently, hydrogen.....or X and Y,” (lines 8-13)

14th line *delete* first, third and fourth formula;

15th line, *deleted*;

16th line after R⁴ *delete* “and R⁵ are”, *replace* it with **—is—**

17th-23th lines, *deleted*;

Claims 3, 6, 14, 15, 23-25 are canceled.

Claim 12, line 1, *delete* “and R5 are”, *replace* it with **—is--**;

Claim 13, line 1, *delete* “and R5 are”, *replace* it with **—is--**;

Claim 32. line 4, *delete* “obesity, eating disorders,” , *replace* it with
--anorexia nervosa, bulimia nervosa--,

line 5, *delete* “sexual dysfunction”, *replace* it with
--premature ejaculation--.

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3. *Reason for Allowance*

The following is an examiner's statement of reasons for allowance: ***

Applicants have limited the claims to the elected compounds which are neither anticipated nor rendered obvious by the art of record. The closest art is US 6,599,915 for which the claims have been demarcated since the bicyclic ring contain Q and Z can not be indole. No suggestion in the art to modify the indolyl ring. The claimed compounds were disclosed to have similar activity as paroxetine in 5HT receptors activity (p.32 specification) and the method of use claims have been limited to those known for paroxetine (see US 5,276,042, US 5,811,436, WO 92/09281). Claims 1-2, 4-5, 7-13, 16-22, 26-35 are allowed.

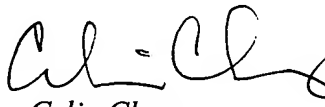
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Apr. 14, 2005


Celia Chang
Primary Examiner
Art Unit 1625